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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/516,850

06/23/2005

Alistair Zorica

50576-2400

7209

21611 7590 04/30/2009  
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EXAMINER

MUROMOTO JR, ROBERT H

ART UNIT

PAPER NUMBER

3765

MAIL DATE

DELIVERY MODE

04/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,850	<b>Applicant(s)</b> ZORICA, ALISTAIR	
	<b>Examiner</b> BOBBY H. MUROMOTO JR	<b>Art Unit</b> 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-22,24,26,27 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-22,24, 26, 27,30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-8, 10-22, 24, 26, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over '319.

'319 discloses a 'combination wetsuit/drysuit for surfing, diving, sailing, marine survival and the like is provided wherein the suit is provided with tight inturned seals at the neck, ankles, and wrists so that it is substantially water tight (abstract).'

'319 clearly discloses a 'fitted garment' that is a 'wetsuit' as claimed.

'319 discloses a first panel (13,15 parts of the single panel) as seen in figure 1, that has a torso region 'substantially surrounding the waist' and having upper portions 'configured' to 'extend' towards an under arm region, as claimed. Figure 1 clearly shows one panel construction and no seams in the armpit region as claimed.

The first panel clearly has leg portions (13, 15) shown in figure 1.

'319 discloses a second panel 11 that is arranged as in claim 5 and 30.

'319 discloses in figure 1, leg darts, having inner knee seams which 'terminate at an outside calf region', as claimed. The newly added 'dart being formed by...without creating a fold' limitations appear to be taught by the figures as no 'fold' is shown. Also this limitation is a product-by-process limitation.

The MPEP is clear, "the lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. **We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different that a product claimed in a product-by-process claim, a rejection based on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.**" *In re Brown*, 459 F.2d 531,535,173 USPQ 685,688 (CCPA 1972).

Therefore since all structural limitations are disclosed the burden is on the applicant to provide evidence that the prior art structure is materially different than that which is claimed.

The wetsuit clearly has no underarm gussets as claimed.

Figure 1 clearly shows the torso of the suit made up of less than 5 panels as claimed.

The methods in claims 26 and 27 are clearly disclosed in the citations above.

Although '319 has explicitly disclosed essentially all of the limitations of the instant invention, '319 has not explicitly taught the limitations in instantly cited claims drawn to specific panel location and seaming arrangement (Claims 3, 4, 7-9, 11-14, 25 and 29), and seam length (claims 20-22).

However, '319 has taught, 'the suit is formed with arm portions 7 and 9, fastened to a body portion 11 and leg portions 13 and 15. **The suit can be formed from various pattern pieces as shown. The curved seam 14 is designed in such a matter to make it improbable that a strain will be placed directly on the seam. Also, since all seams are stiff, this curve design allows greater elongation by the fact that when tension is put on a curve seam, there is greater flexibility than if it is a straight seam. The sections are joined by means well known to those skilled in the art such as cementing or sewing or, preferably, a combination of both sewing and cementing.**"

Additionally, garment pattern design variation is a well-known and widely practiced technique, as evidenced by '319 teaching above and numerous garment patterning references attached in PTO-892. All garment patterns are designed with various panels depending on the various needs of the end use garment.

Therefore it would have been obvious to one of ordinary skill in the art of garment production to use various garment pattern pieces, that result in various panel and seaming locations for the finished garment to produce a garment that reduces direct strain on the seams.

With respect to the exact seam length, the obvious variation above applies as well as that with respect to changes in size and proportion the MPEP states:

### **Changes in Size/Proportion**

*In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Since the only difference between the prior art and the claimed device is the recitation of relative dimension of the seam length total, and the prior art device clearly teaches seam and pattern design to decrease stress on the seam like the claimed invention, the claimed invention is not patentably distinct and therefore would have been obvious to one of ordinary skill in the art.

### ***Response to Arguments***

Applicant's arguments filed 4/6/2009 have been fully considered but they are not persuasive.

Applicant's argues that the reference teaches away from reducing seam length. This argument is incorrect. Nothing in the reference speaks to the inoperability of using

Art Unit: 3765

shorter seams. O'Neill clearly teaches variation in seam shapes which would inherently call for varied seam length.

Applicant argues no teachings in the reference teach single panel construction, however, reference numerals 13, 15 are parts of a single panel, also with regards to such modifications the MPEP cites, "*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "**that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.**"

Applicant has incorrectly attributed darts to one piece of material. Darts are known as tapered seams, they are not limited to only one piece of material.

All other arguments are drawn to the claim limitations that are a result of variation in garment design that has been clearly addressed above.

Newly added 'dart' formation limitations are addressed above.

Since these are the arguments the rejections remain and are considered to be proper.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOBBY H. MUROMOTO JR whose telephone number is (571)272-4991. The examiner can normally be reached on 8-530, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert H Muromoto, Jr./  
Primary Examiner, Art Unit 3765